UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

08/446804

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

08/446,804 06/01/95 AMBROSIO T PD03401K

F3M1/0305

ROBERT A FRANKS
SCHERING-PLOUGH CORPORATION
ONE GIRALDA FARMS
MADISON NJ 07940-1000

EXAMINER	
RACHITI,E	
ART UNIT	PAPER NUMBER
3	6

DATE MAILED:

03/05/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

Please See Attachment

Applicant's reply received January 22, 1996 is not deemed to be fully responsive to the prior Office action because it fails to elect a single species of the invention for examination purposes as required by the requirement for election mailed December 20, 1995.[1] Since the period for response set in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 C.F.R. § 1.136(a).

The date on which the corrected response, the petition under 37 C.F.R. § 1.136(a), and petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the six month statutory period or obtain an extension for more than four months beyond the date of response set in an Office action.

RESPONSE TO REMARKS

Applicant's remarks have been fully considered. To the extent that they are not addressed *supra*, these comments are presented for Applicant's consideration in advancing prosecution.

Applicants aver that because the instant application is filed pursuant to 35 U.S.C. § 371, only rules governing unity of invention under the PCT treaty are applicable, and not the rules governing U.S. Restriction practice during the national stage. Applicants argue that election of species requirements cannot be made consonant with the Treaty.

The Examiner does not find this argument to be persuasive. Firstly, a distinction is drawn

---

[1] *See* MPEP § 714.03.

between a requirement to elect between distinct inventions and the election of species.[2] Unity of Invention under the PCT treaty concerns the requirement to elect between distinct inventions,[3] and not the election of a single disclosed species for examination purposes. As argued by applicants, it is not disputed that unity of invention practice is required in the place of restriction

---

[2] 802.02 Definition of Restriction

Restriction, a generic term, includes that practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, and election of species.

[3] 37 CFR 1.475. Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a *single general inventive concept* ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim (emphasis added).

practice in applications filed under 35 U.S.C. § 371, but this restriction practice is specifically referenced as that set forth in MPEP § 806+.[4] Section 806 of the MPEP concerns distinctness or independence of claimed inventions.[5] Section 808 of the MPEP again draws a distinction between related or independent inventions,[6] and the election of species.[7]

It is therefore not an abrogation of the PCT treaty for the Office to require an election of species for examination purposes in an application filed under 35 U.S.C. § 371. This practice is not superseded by Unity of Invention practice, as is restriction between independent or related

---

[4] MPEP § 201

(1) Restriction practice under MPEP §806+ to national applications under 35 U.S.C. 111(a) while unity of invention practice under MPEP Chapter 1800 is applied to national stage applications under 35 U.S.C. 371.

[5] 806 Determination of Distinctness or Independence of Claimed Inventions

The general principles relating to distinctness or independence may be summarized as follows:

1. Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.04 - § 806.04(j), though a reasonable number of species may be claimed when there is an allowed (novel and unobvious) claim generic thereto, 37 CFR 1.141, MPEP § 809.02 - § 809.02(e).

2. Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.

3. Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Since, restriction is required by the Office double patenting cannot be held, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (2) and (3) see MPEP § 806.05 - § 802.01 for criteria for patentably distinct inventions.

[6] MPEP §§ 808.01, 808.02.

[7] 808.01(a)

In all applications in which no species claims are present and a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required, a requirement for an election of species should be made prior to a search of the generic claim.

inventions, because it is a separate and distinct practice.[8]

Applicants' response of January 22, 1996, stating only that they are not required to elect a single disclosed species for examination purposes, is non responsive.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Raciti whose telephone number is (703) 308-0400. The Examiner may normally be reached between 9:00 AM and 5:30 PM EDT. The Fax number for Art Unit 3307 is (703) 308-2864.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

EDGAR S. BURR
S.P.E.
GROUP ART UNIT 337

E. P. Raciti
Examiner, AU 3307

---

[8] 806.04(b) Species May Be Related Inventions [R-1]

Species, while usually independent may be related under the particular disclosure. Where inventions as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP § 806.05 - § 806.05(i).